



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/612,087 | 07/03/2003 | Kazaya Katoh | 24-007 | 5849 |
| 23400 | 7590 | 06/13/2006 | EXAMINER | |
| POSZ LAW GROUP, PLC 12040 SOUTH LAKES DRIVE SUITE 101 RESTON, VA 20191 | | | | AHMAD, NASSER |
| ART UNIT | | PAPER NUMBER | | |
| | | | | 1772 |

DATE MAILED: 06/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/612,087 | KATOH ET AL. | |
| | Examiner | Art Unit | |
| | Nasser Ahmad | 1772 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 23 March 2006.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-7 and 9-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,3,5,6,9,15,18 and 21 is/are rejected.
- 7) Claim(s) 2,4,7,16,17 and 19 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 03 July 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Rejections Maintained

1. Claims 1, 3, 6, 9, 18 and newly submitted claim 21 are rejected under 35 U.S.C. 102(b) as being anticipated by The Partial English Translation of German DE 599159 for reasons of record made in the last Office Action of November 30, 2005.
2. Claims 5 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over The Partial English Translation of the German patent for reasons of record made in the last Office Action of November 30, 2005.

Response to Arguments

3. Applicant's arguments filed March 23, 2006 have been fully considered but they are not persuasive.

Applicant's explanation that the amendment made broadens the scope of the claimed invention is noted.

Applicant argues that the DE'159 reference fails to teach that the protective member is spaced apart from the adhesive portion. This is not found to be convincing because, as explained in the last Office Action and also acknowledged by the applicant in the amendment of March 23, 2006, page-8, lines 8-11, the adhesive can be omitted in the center. When the adhesive is omitted in the center, the protective member is spaced from the adhesive sheet portions, and hence do not overlap as per instant claim 1.

Responding to applicant's allegation that the wafers of DE'159 are firmly stuck onto the adhesive sheet portion is not found to be persuasive because, while it is true that for the

wafer to be stuck in-place on the sheet, it must be adhered to the sheet by some means, however, it is not the adhesive of the adhesive sheet portion that hold the wafer in-place. In fact, applicant has failed to show support therefor from the DE'159 reference.

Applicant argues that the DE'159 fails to teach that the adhesive sheet portions are "formed from an adhesive sheet laminated on along release sheet". This is not deemed to be convincing because, when the laminate of the DE'159 reference is formed into a roll the sheet is releasable from the adjacent sheet which acts as the release sheet.

Regarding the dependent claims, the above explanations apply *a fortiori* herein.

Regarding the newly submitted claim21, it has been grouped together with the above rejection because the base material and the adhesive are interpreted to be of same material, in the absence of any showing otherwise by the applicant.

Thus, the absence of any evidence to the contrary, it remains the examiner's position that the claimed invention is anticipated or rendered obvious over the prior art of record discussed.

Allowable Subject Matter

4. Claims 2, 4, 7, 16-17, 19 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art uncovered so far fails to teach that the cover sheet portions are provided longitudinally in the central portion of the release sheet with the protective member is

Art Unit: 1772

provided on both side portions of the release sheet, or that the adhesive sheet comprises a resin base and an adhesive layer.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1772

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Nasser Ahmad
Primary Examiner
Art Unit 1772

N. Ahmad.
June 9, 2006.